



REMARKS

The Applicant has received and reviewed the Office's Notice of Non-Compliant Amendment dated April 27, 2005 wherein the Office indicated that the claims submitted in the Office Action dated August 9, 2004 and in the Notice of Non-Compliant dated February 3, 2005 was considered non-compliant because "amend claims do not include markings indicating the changes made to the claims."

In reviewing the Applicant's responses of August 2004 and January 2004, it has come to the Applicant's attention that there was an inconsistency in the claims in the Applicant's files and in the Office's records. In view of the aforementioned the Applicant's Attorney called Examiner Courson and asked for a copy of the current claims on file in the Office's records for the above-identified application in order to rectify the non-compliance. The Applicant's Attorney thanks Examiner Courson for providing the Applicant's attorney with the aforementioned.

This present response thus comprises the Applicant's response to the Office's the Notice of Non-Compliant of February 3, 2005 and April 27, 2005 and the Applicant's response to the Office Action dated May 5, 2004. Since the time to respond to the Office's the Notice of Non-Compliant of April 27, 2005 expired on March 3, 2005, the Applicant has also include a petition for a three month extension of time up to June 3, 2005 along with the payment of the associated fees.

**APPLICANT'S RESPONSE TO
OFFICE ACTION DATED MAY 5, 2004**

In the Office Action dated May 5, 2004, the Office objected to claim 11 due to informalities, rejected claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over the reference of Ebinger (US Patent No. 3,709,112) in view of the reference of Stuart (US Patent No. 6,461,084); rejected claims 1-7 and 11-12 "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 in view of Ebinger (U.S. Patent No. 3,709,112)" and rejected claims 8-10 under "the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4 of U.S. Patent No. 6,099,203 in view of U.S. Patent No. 3,709,112 (Ebinger)."

Objection to the claims

Claim 11 stands objected to due to informalities. More specifically, the Office on page 2, lines 3-4 of the Office Action noted that the phrase "said anchoring flaps" in lines 1-2 of claim 11 lacks antecedent basis. In response to the Office's aforementioned objection, Applicant has amended claim 11 to now depend on independent claim 8, independent claim 8 providing for proper antecedent basis for claim 11. Please note that the Applicant has also amended claim 12 to also depend on independent claim 8.

In view of the Applicant's above amendments to the claims, it is respectfully requested that the Office's objection to dependent claim 11 be withdrawn.

**Rejection under 35 U.S.C. 103(a) to the
combination of Ebinger and Stuart**

Claims 1-6, 8-9, and 11-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the reference of Ebinger (US Patent No. 3,709,112) in view of the reference of Stuart (US Patent No. 6,461,084).

In regards to Applicant's claims 7 and 10, the Applicant has canceled claims 7 and 10 from the application.

**A. Combination of Ebinger and Stuart does
not teach Applicant's claims 1-6, 8-9, and 11-12**

In regards to claims 1-6, 8-9, and 11-12, in the above rejection of Applicant's claims 1-6, 8-9, and 11-12, the Office has taken the position that Applicant's invention is obvious based on the teaching of Ebinger and Stuart. Applicant submits it is the opposite, namely, that the teaching of Stuart makes it unobvious to incorporate anchoring flaps directly into a marker post. Note that Ebinger has a post 1 with no anchoring flaps. Similarly, Stuart has a post 2 that has no anchoring flaps. Thus both the post of Ebinger and the post of Stuart lack any anchoring flaps. However, it is acknowledged that Stuart wishes to anchor his post. To anchor his post 2 Stuart goes to elaborate lengths to avoid placing any anchoring flaps on his post. That is, instead of teaching the placement of anchoring flaps directly on his post Stuart teaches one to put ground engaging members on a multi-finned stake, which is driven into the ground. He then uses a clamp 5 to anchor his post, not to the ground but to a collet 4 that is welded to his stake 1. More specifically, Stuart teaches one to weld flat fins 1a to each other to form a separate stake 1 in the shape of a cross (see Fig. 3). The stake 1 is then driven into

the ground. Stuart's stake 1, has deflectable portions 11 to engage his fin 1a with the ground. Once Stuart's stake 1 is driven into the ground a collet 4 is welded to his stake 1. Next, one end of a clamping member 5 engages the collet and the other end of the clamping member engages his post 2 to anchor his post 2 to his stake 1. Thus, when one considers the art as a whole, it is clear Stuart teaches one to go to great lengths and considerable effort to avoid placing any anchoring flaps directly on his post 2 and that he teaches using a clamp 5 to anchor his post to a separate stake 1.

Applicant's independent claim 1 has been amended to now call for marker post comprising a one-piece hollow elongated member "drivable into a top layer of soil." Applicant's independent claim 8 has been amended to now call for a hollow anchoring marker post comprising a one-piece triangular shaped elongated member "drivable into a top layer of soil." Support for the above amendment to independent claim 1 and 8 can be found for example in canceled claim 7.

It is submitted that neither the reference of Ebinger or the reference of Stuart teaches the above. In regards to the reference of Stuart, it is respectfully submitted that the reference of Stuart does not teach a marker post that is drivable into a top layer of soil.

Instead, the reference of Stuart teaches a three-piece device comprising a post 2, a ground-engaging portion 1 such as "...a stake formed from pressed metal fins that are welded together," and collets 4. The collets 4 are engageable to an upper portion of the metal ground-engaging portion 1 to form a post-receiving portion wherein the collets 4 work in conjunction with a clamping member 5 located around the collets 4 for securing the post 2 to the ground-

engaging portion. As such, Stuart's post 2 is secured to the upper portion of Stuart's metal ground-engaging portion 1. In the operation of Stuart's device, a portion of Stuart's ground-engaging portion 1 is embedded into the ground. (See column 2, lines 1-34.) Once Stuart's ground-engaging portion 1 is embedded, Stuart's collets 4 and clamping member 5 (located around the collets 4) secures his post 2 to the ground-engaging portion 1.

As the reference of Stuart does not teach the embedment of his post 2 into the ground but instead teach a separate member, namely a ground-engaging portion 1 comprising a metal stake that is embedded into the ground after which his post 2 is secured thereto, it is respectfully submitted that Stuart thus does not teach a post that is drivable into a top layer of soil.

In regards to the reference of Ebinger, the Office on page 3, lines 8-9 and 18-19 of the Office Action stated that the reference of Ebinger teaches a device:

"... wherein said elongated member is sufficiently stiff to permit the marker post to be driven into a top layer of soil (Fig. 1)."

The Applicant respectfully disagrees with the Office's above statement. It is submitted that the reference of Ebinger also does not teach his device as being "... drivable into a top layer of soil ..." but instead teaches away from the aforementioned as Ebinger, in column 2, lines 8-12 specifically teaches that once his device is embedded in the ground, that his device is then "... filled with loose or hardened bulk material ..." and it is preferred that:

"... the filling be kept at about ground level so that the post will bend over readily if struck by an automobile but will immediately spring back up after the vehicle passes over it." (Emphasis added, see column 2, lines 17-21.)

It is submitted that if Ebinger's hollow device (which is opened at the end that the device is embedded into the ground) is drivable into the soil, that the interior of Ebinger's hollow device would not need to be filled with material(s) to ground level because the driving of Ebinger's hollow device into the soil would result in the presence of soil located within the interior of the hollow device at ground level.

In further regards to the Office's above rejection of claims 1-6, 8-9, and 11-12, Applicant's claims 1, 2 and 8 also calls for a one piece hollow elongated member having integral anchoring flaps located thereon, the anchoring flaps each being:

"... moveable from a first closed position to facilitate the handling and transportation of said marker post to a second open position to prevent the withdrawal of said one-piece hollow elongated member from an embedded position and vice versa." (Emphasis added.)

It is submitted that neither the reference of Ebinger or the reference of Stuart teaches the above. In regards to the reference of Ebinger, it is submitted per the Office's statement on page 4, lines 1-10 of the Office Action that the reference of Ebinger does not teach the above.

In regards to the reference of Stuart, the Office, on page 4, lines 20-21 and page 5, lines 1-15 of the Office Action dated May 5, 2005, stated:

"Stuart teaches a post that consists of a first integral anchoring flap, a second integral anchoring flap, and a third integral anchoring flap (Figs. 1 and 4, deflectable portions 11), each of said anchoring flaps having a first end and a second end (Figs. 1 and 4),

each of said anchoring flaps located proximate a second end of said elongated member (Figs. 1 and 4), a first hinge, a second hinge, and a third hinge (Figs. 1 and 4, deflectable portions 11), the second end of said first anchoring flap attached to the first panel of said elongated member by said first hinge (Fig. 1), the second end of said second anchoring flap attached to the second panel of said elongated member by said second hinge (Fig. 1), the second end of said third anchoring flap attached to the third panel of said elongated member by said third hinge (Fig. 1), each of said anchoring flaps moveable from a first closed position to facilitate the handling and transportation of said marker (column 3, lines 37-40. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the guide post of Ebinger, so as to include integral anchoring flaps with hinges attached to a panel, as taught by Stuart, so as to enhance the engagement of the post to the ground (column 3, lines 39-40)."

The Applicant respectfully disagrees with the Office's above statement. Referring to Figure 1 of Stuart, note that although Stuart teaches the use of deflectable portions 11 (see Figure 4), Stuart's deflectable portions 11 are specifically shown as being located on Stuart's ground engaging portion 1 and not located on and integral to Stuart's post 2. It is submitted that Stuart's ground engaging portion 1 comprising a metal stake and Stuart's post 2 are two different members of his three-part device.

The reference of Stuart also does not teach his deflectable portions 11 as being moveable from a first closed position to a second open position and vice versa as called for in Applicant's claims 1, 2 and 8. Although Stuart in column 3, lines 37-40 teaches that "... a number of deflectable portions, such as 11 which may be pushed from the fin 1a so as to enhance the engagement of the fin with the ground," it is submitted that Stuart does not teach that his deflectable portions may be moved back to their original position after his deflectable portions have been pushed from his fin 1a.

Instead, it is submitted that Stuart actually teaches away from the aforementioned by disclosing in column 3, lines 34-40 that his fin (and in turn the deflectable portions 11) are formed by "... laser cut from a single sheet of metal or punched from a coil of metal."

(Emphasis added.) Note in column 2, lines 10-11 wherein Stuart further teaches that his:

"... ground engaging portion is suitably a stake formed from pressed metal fins that are welded together." (Emphasis added.)

In further regards to the above, Applicant's amended claims 1, 2, and 8 call for flexible living hinges, the flexible living hinges connecting the Applicant's anchoring flaps to the Applicant's elongate member thereby enabling the anchoring flaps to be moveable from a first closed position to a second open position and vice versa. It is submitted that the reference of Stuart does not teach the use of flexible living hinges.

It is further noted that the reference of Stuart also does not teach his post anchor as comprising a one-piece hollow elongated member as Stuart's ground engaging portion 1 is not hollow and is further shown as a separate member from Stuart's post 2. (See Figures 2-9 of Stuart.)

It is for the above reasons that Applicant's respectfully submits that the Applicant's independent claims 1, 2, and 8, as amended, are allowable over the combination of the reference of Ebinger in view of the reference of Stuart.

B. Not obvious to combine Ebinger and Stuart

In further regards to the Office's rejection of claims 1-6, 8-9, and 11-12 under 35 U.S.C. 103(a) as being unpatentable over the reference of Ebinger in view of the reference of Stuart, it is further submitted that it would not have obvious to combine the reference of Ebinger with the reference of Stuart as the aforementioned references teach away from each other.

Note that the reference of Stuart teaches a three-part device comprising a post 2, a ground engaging portion 1 and collets 4 (column 2, lines 1-34) wherein the:

"... ground engaging portion is suitably a stake formed from pressed metal fins that are welded together..." (column 2, lines 10-11)

or is form by:

"... laser cut from a single sheet of metal or punched from a coil of metal ..." (column 3, lines 34-40, emphasis added).

The reference of Ebinger, on the other hand, teaches a one-piece device comprising:

"... a road guide post consisting of plastic material and having over its whole length a hollow tubular shape ..." (Emphasis added, column 1, lines 51-54.)

It is respectfully submitted that by disclosing a one-piece device comprising a road guide post consisting of plastic material that the reference of Ebinger teaches away from Stuart's three-piece device comprising a post 2, a ground engaging portion 1 and collets wherein the ground engaging portion is formed from metal.

In further regards to the above, note that the reference of Ebinger also teaches away from the reference of Stuart as Ebinger discloses a partially embedded guide post that has the ability to right itself when repeatedly struck (column 1, lines 66-67) whereas Stuart discloses a post that is specifically secured to Stuart's embedded member (i.e. the post is located above the ground) thereby allowing the post to be easily replaced if damaged such as by the impact of a vehicle (column 1, lines 20-21 and column 4, lines 56-58).

It is for the above reason that Applicant's submits that the Applicant's claims 1-6, 8-9, and 11-12, as amended, are allowable over the combination of the reference of Ebinger in view of the reference of Stuart.

**Rejection under 35 U.S.C. 103(a) under
obviousness-type double patenting**

Claims 1-6 and 11-12 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,099,203 in view of the reference of Ebinger (U.S. Patent No. 3,709,112).

Claims 8-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 4 of U.S. Patent No. 6,099,203 in view of the reference of Ebinger.

Applicant respectfully disagree with the Office's above rejection of the Applicant's claims based on the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,099,203 in view of the reference of Ebinger.

It is submitted that Applicant's claimed subject matter is different from U.S. patent 6,099,203 or Ebinger U.S. patent 3,709,112. Note, U.S. patent 6,099,203 is directed to a marker post having "... internal webs coacting to provide a restoring force to enable the marker under many field conditions to return to a normal straight condition" (Abstract lines 5-8). Thus, the claims of patent U.S. 6,099,203 are directed to integral coacting webs within a post and the Ebinger patent 3,709,112 is directed to a polyethylene post with neither U.S. patent 6,099,203 or Ebinger patent 3,709,112 teaching the use of applicant's claimed anchoring flap. In addition, neither U.S. patent 6,099,203 or Ebinger U.S. patent 3,709,112 teach the use of applicant's claimed living hinge. Since neither reference teach the above features of applicant's claims it is submitted that a judicial based double patenting rejection based on obviousness is in error.

Notwithstanding the above, the Applicant is willing to file a terminal disclaimer in compliance with 37 CFR 1.321(c) in the event that there are allowable claims and the double patenting rejection is maintained.

In further regards to the Applicant's dependent claims 2-6, 9 and 11-12, Applicant's claims 2-6 each depends on Applicant's independent claim 1. Since Applicant's independent claim 1, as amended, is allowable for the reasons given above, Applicant's dependent claims 2-6 should also be allowable. Applicant's dependent claims 9 and 11-12 each depend on Applicant's independent claim 8. Since Applicant's independent claim 8, as amended, is

allowable for the reasons given above, Applicant's dependent claims 9 and 11-12 are also allowable.

In view of the above, it is submitted that the applicant is in condition for allowance.

Allowance of claims 1-6, 8, 9 and 11-12, as amended, is respectfully requested. Applicant has enclosed a version of the amended claims showing changes made with this response.

A response to the Notice of Non-compliance was due on March 3, 2005. In view of the aforementioned, also enclosed is a petition for a three month extension of time up to June 3, 2005 along with the payment of the associated fees. Please charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. 10-0210.

Respectfully submitted,

JACOBSON AND JOHNSON

By



Carl L. Johnson, Reg. No. 24,273
Attorneys for Applicant
Suite 285
One West Water Street
St. Paul, Minnesota 55107-2080
Telephone: 651- 222-3775
Fax: 651-222-3776

CLJ/cj
Enclosure